

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 10/031,330

REMARKS

Upon entry of this amendment, claims 2-11 are all the claims pending in the application. New claims 5-11 have been added. No new matter has been added.

Applicant thanks the Examiner for initialing the references listed on form PTO-1449 submitted with the Information Disclosure Statement filed on January 18, 2002.

I. Claim Rejections under 35 U.S.C. § 103(a)

A. Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kiyoshi (U.S. Patent No. 4,797,526) in view of Hazelton et al. (U.S. Patent No. 6,323,567) and Hartzell, Jr. et al. (U.S. Patent No. 5,834,862). Applicant respectfully traverses this rejection on the following basis.

Claim 2 defines a novel combination of features which forms an electric discharge machining apparatus. Included among the features of this new apparatus is a magnet supporting plate for supporting a magnet which is on the secondary side of the linear motor, a base plate formed with a hole portion, and a spacer for holding the magnet supporting plate and the base plate while leaving a predetermined distance therebetween. Applicant submits that the claimed combination, including at least these features, is neither taught nor suggested by the cited prior art.

The Examiner recognizes that Kiyoshi does not teach a magnet supporting plate, a base plate, and a spacer as claimed. To cure this deficiency, the Examiner applies Hazelton and asserts that Hazelton teaches such features. Applicant respectfully disagrees.

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The Examiner asserts that Hazelton discloses spacers 82 used to space the coil assembly 16 apart from the housing. As clearly shown in Fig. 3, the spacers 82 are used to hold the coil assembly 16 apart from the end sections 48 and 50, thereby leaving a predetermined space therebetween (see column 7, lines 2-4). Accordingly, it appears as though the Examiner is taking the position that end sections 48 and 50 correspond to the base plate as claimed and that coil assembly 16 corresponds to the magnet supporting plate as claimed. Applicant respectfully disagrees.

In particular, Applicant respectfully submits that the coil assembly 16 does not support magnet 22 and, therefore, coil assembly 16 cannot constitute a magnet supporting plate as suggested by the Examiner. Rather, magnet 22 is supported by magnet housing 18 and magnet housing 18 is supported by housing apertures 58 (see Figs 2 and 3). In no way, however, is coil assembly 16 responsible for supporting magnet 22. Indeed, Hazelton does not even remotely suggest such a capability.

In addition, Applicant points out that claim 2 does not merely recite a magnet supporting plate for supporting a magnet. Rather, claim 2 specifically requires a magnet supporting plate for supporting a magnet which is on the secondary side of the linear motor. The Examiner, however has not addressed this feature of the claim. Applicant submits that Hazelton fails to teach or suggest such a feature.

Further, Applicant submits that both Kiyoshi and Hartzell, Jr. fail to cure the deficiencies of Hazelton as discussed above. Accordingly, as the combination of Kiyoshi, Hazelton, and Hartzell, Jr. fails to teach or suggest all of the features of claim 2; Applicant submits that a prima

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facie case of obviousness has not been established and respectfully requests that the rejection be reconsidered and withdrawn.

B. Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kiyoshi in view of Hazelton et al. and Hartzell, Jr. as applied to claim 2 above, and further in view of Sedgewick et al. (U.S. Patent No. 5,998,890).

Claim 3 depends from claim 2 and therefore incorporates all of the limitations thereof. Applicant submits that Sedgewick fails to cure the deficiencies of Kiyoshi, Hazelton and Hartzell, Jr. as discussed above regarding claim 2. Accordingly, Applicant submits that claim 3 is patentable at least by virtue of its dependency.

C. Claim 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kiyoshi et al. in view of Hazelton et al. and Hartzell, Jr. as applied to claim 2 above, and further in view of Parison et al. (U.S. Patent No. 5,701,039).

Claim 4 depends from claim 2 and therefore incorporates all of the limitations thereof. Applicant submits that Parison fails to cure the deficiencies of Kiyoshi, Hazelton and Hartzell, Jr. as discussed above regarding claim 2. Accordingly, Applicant submits that claim 4 is patentable at least by virtue of its dependency.

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II. New Claims


New claims 5-11 are added. Applicant submits that these claims are patentable based on the combination of features recited therein.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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